

REMARKS

Claims 1-6 and 13-16 are pending in this application. Non-elected claims 13-16 have been withdrawn from consideration by the Examiner. By this Amendment, claims 1-6 and 13-16 are amended, and claims 7-12 are canceled. Support for the amendments to the claims may be found, for example, in the original claims. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Information Disclosure Statement

An Information Disclosure Statement with Form PTO-1449 was filed in this patent application on February 3, 2006. The initialed copy of the PTO-1449 attached to the Office Action fails to acknowledge consideration of items 7 and 10 (the references numbered "JP A 59-110691" and "WO 97/40009 A1"). Accordingly, the Examiner is requested to initial and return to the undersigned a copy of the subject Form PTO-1449 acknowledging consideration of the references numbered "JP A 59-110691" and "WO 97/40009 A1."

II. Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 1-6 as being indefinite under 35 U.S.C. §112, second paragraph. By this Amendment, claims 1, 5, and 6 are amended to overcome the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1-6 under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,187,944 to Koyanagi et al. (herein "Koyanagi"). Applicants respectfully traverse the rejection.

Claim 1 recites "[a] process for stereoselectively producing an E-3-acyloxyacrylonitrile compound of formula (3) or a Z-3-acyloxyacrylonitrile compound of formula (4) which comprises reacting a 3-oxopropionitrile compound of formula (1) with an

acid chloride of formula (2) wherein ... the reaction is conducted with removal of hydrogen chloride as a by-product from the system without using a base, or by using an organic base as a base or an inorganic base of alkali metal or alkaline earth metal as a base, to thereby regulate the stereostructure of the reaction product."

The reaction of the compound of formula (1) and the compound of formula (2) with removal of hydrogen chloride from the system without using a base selectively produces an E-3-acyloxyacrylonitrile. See specification, paragraph [0015]. Similarly, the reaction of the compounds of formula (1) and (2) with removal of hydrogen chloride from the system using an organic base selectively produces an E-3-acyloxyacrylonitrile. See specification, paragraph [0015]. In contrast, the reaction of the compounds of formula (1) and (2) by using an inorganic base of alkali metal or alkaline earth metal selectively produces a Z-3-acyloxyacrylonitrile. See specification, paragraph [0015].

Koyanagi fails to teach or suggest stereoselectively producing an E- or Z-3-acyloxyacrylonitrile. Specifically, Koyanagi fails to teach or suggest reacting the compound of formula (1) and the compound of formula (2) with removal of hydrogen chloride:

- (1) without using a base;
- (2) by using an organic base; or
- (3) by using an inorganic base of alkali metal or alkaline earth metal.

One of ordinary skill in the art would not have modified any process disclosed by Koyanagi to practice the claimed method because Koyanagi provides no reason or rationale to stereoselectively produce an E or a Z-3-acyloxyacrylonitrile. The Office Action acknowledges that "Koyanagi is silent on whether the compounds prepared are either the E or Z isoform." See Office Action, page 5. Accordingly, Koyanagi fails to teach or suggest each and every feature as recited in claim 1.

For at least these reasons, claim 1 would not have been rendered obvious by Koyanagi. Claims 2-6 depend from claim 1 and, thus, also would not have been rendered obvious by Koyanagi. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Rejoinder

Applicants respectfully request rejoinder of withdrawn claims 13-16. Withdrawn claims 13-16 depend from claim 1 and therefore contain all features of claim 1. Because these features are believed to distinguish over the prior art for at least the reasons discussed above, all the claims share a special technical feature. As such, Applicants respectfully submit that unity of invention exists between the claims, and thus request withdrawal of the Restriction Requirement and rejoinder of the withdrawn claims.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Matthew C. Barthalow
Registration No. 60,323

JAO:CSM/sxl

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OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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